

U.S. Application No. 10/628,373

Atty. Docket No. 20435-00141-US1

**REMARKS****Status of Claims:**

Claims 1-58 were pending in the application. Claims 10, 45, and 49 are hereby canceled without prejudice to, or disclaimer of, any subject matter contained therein. The Applicant reserves the right to further prosecute the subject matter of the present application, including any canceled claims in subsequent division, continuation, and/or continuation-in-part application(s). Claims 1-44, 46-48, and 50-58 are now pending. Each pending claim defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

**Rejections Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph:**

Claims 1-24 were rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, as being indefinite in view of various informal recitations.

Claims 1 and 51 are hereby amended to present recitations suggested by the Examiner.

Claims 3-5 are amended to depend from Claim 2 which provides antecedent basis for recitations of the amended claims.

Claim 10 is hereby canceled.

Claims 13, 16, and 19 are hereby amended to present recitations suggested by the Examiner.

Claim 32 is amended to depend from claim 31 in view of antecedent basis.

In Claim 40, the recitation "simple" is canceled.

Claim 44 is amended to depend from claim 43 in view of antecedent basis.

Claim 46 is hereby amended to present recitations suggested by the Examiner.

Claim 49 is canceled.

Claims 57 and 58 is amended to recite the monoacrylate is present "up to" a specified mol%.

Claim 50 is hereby amended to present recitations suggested by the Examiner.

**Rejections Under 35 U.S.C. § 103(a):**

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Claims 1-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ostlie (5,876,805) in view of Moy (5,945,489).

To establish *prima facie* obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art. *In re Royka*.<sup>1</sup> All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*.<sup>2</sup> (MPEP § 2143.03). When evaluating the scope of a claim, every recitation in the claim must be considered. See e.g. *In re Ochiai*.<sup>3</sup> (MPEP § 2144.08). The evidentiary record fails to teach each recitation of the present invention. Specifically, the references taken as a whole or severally fail to teach the absence of exogenous photoinitiator.

The Examiner cites Ostlie as disclosing photopolymerizable thiol-ene compositions wherein the -ene compound can be a multifunctional acrylate. The Examiner further suggests Ostlie's thiols correspond to those of the present invention. The Examiner notes Ostlie does not teach the Michael addition products of the present invention. The Examiner cites Moy as teaching Michael addition products. the Examiner further notes Moy does not teach thiol compounds.

Ostlie relates to photocuring compositions in the presence of exogenous photoinitiator. Ostlie discloses compositions that comprise "at least one acyl phosphine oxide photoinitiator."

The present response amends Claims 1, 45, and 51 to recite "the substantial absence of exogenous photoinitiator," and cancels claims 45 and 49. To clarify that the invention comprehends compositions and methods in the substantial absence of exogenous photoinitiator. Support for the recitation added by amendment was present in the original submission at, for example, paragraph [0042], lines 4-5.

In contrast to the present invention, which recites the substantial absence of exogenous photoinitiator, Ostlie requires "at least one acyl phosphine oxide photoinitiator." Moy was cited as teaching Michael addition products which does not provide the teaching missing from Ostlie.

#### Conclusion:

In view of the above, consideration and allowance are respectfully solicited.

<sup>1</sup> *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>2</sup> *In re Wilson*, 424 F.2d 1382, 165 USPQ 496 (CCPA 1970).

<sup>3</sup> *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).

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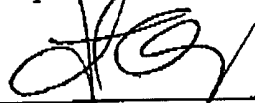
Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

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Respectfully submitted,



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